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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,438	07/31/2001	Shin Hiwasa	1214-011212	1754
28289	7590	10/14/2005	EXAMINER	
THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			LAVILLA, MICHAEL E	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,438

Applicant(s)

HIWASA, SHIN

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 19 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 19 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 24-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The amendment filed 28 July 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment at pages 5 and 6 that adds the text "(2-ferroceniummethyl) ferrocenium cation" appears to introduce new matter. The basis for the amendment is apparently the formula at page 4, which encompasses this cation. However, the formula and accompanying description do not appear to lead one of ordinary skill in the art to this cation as opposed to any of the others encompassed by the formula. Therefore, it is unclear how applicant has established that the disclosure reasonably conveys to one of ordinary skill in the art that applicant was in possession of this subject matter at the time of filing.
2. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
4. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear how the disclosure of the formula at page 4 and the accompanying discussion reasonably convey to one of ordinary skill in the art that applicant at the time of filing was in possession of the claimed cation, namely, (2-ferroceniummethyl) ferrocenium cation, as a species of the generic formula provided on page 4.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
 7. A person shall be entitled to a patent unless –
 8. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
9. Claims 16, 19, and 21-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Shouzaki et al. USP 6,100,352 for the reasons of record in the Office Action mailed on 26 April 2005.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 16, 19, and 21-23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Shouzaki et al. USP 6,100,352 for the reasons of record in the Office Action mailed on 26 April 2005.

Response to Amendment

- I. In view of applicant's amendments and arguments, the claim objections of the Office Action mailed on 26 April 2005 are withdrawn.
- II. In view of applicant's amendments and arguments, the section 112, second paragraph rejections of the Office Action mailed on 26 April 2005 are withdrawn.
- III. In view of applicant's amendments and arguments, applicant traverses the section 102 and 103 rejections over Shouzaki of the Office Action mailed on 26 April 2005. Applicant argues that the catalyst of Shouzaki comprises additional ingredients that should be precluded by the claimed "consists of" language

of Claim 16. Referencing applicant's argument at page 8 of the Response of 28 July 2005, Shouzaki's catalyst requires ingredients (a), (b1), possibly (b2), and possibly (d), whereas the claimed materials would seemingly only involve the (b1) component. That the claimed compounds encompass Shouzaki's (b1) component is apparent at col. 14, lines 40 et seq., where disclosed (b1) compounds that meet the requirements of formula (XVII) in Shouzaki are listed, including "ferrocenium tetraphenylborate," among others. These compounds are encompassed by the formula of Claim 16. Shouzaki teaches forming the catalyst of Shouzaki by mixing (b1) compounds with other ingredients of the catalyst of Shouzaki. See, for example, col. 17, lines 1-12. Therefore, Shouzaki's (b1) compounds, which are encompassed by the claimed formula of Claim 16, are taught in isolation, which the "consists of" language of Claim 16 requires. Since the (b1) compounds are taught in isolation, the claimed invention is taught, notwithstanding that Shouzaki may utilize the compounds in a different catalytic process that requires the presence of additional co-catalyst ingredients. Rejection is maintained.

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- IV. Rejection under double patenting and sections 102 or 103 over Hiwasa USP 6,387,975 and rejection under sections 102 or 103 over Hiwasa WO 99/06419 are not appropriate since the n values of four or five in these references are not encompassed or suggested by the claimed n values of zero to three in the claimed formula of Claim 16.
- V. Rejections under sections 102 or 103 over Sato USP 6,660,816 are not appropriate since Sato does not teach or suggest forming an initiator that consists of the claimed crystalline ion-association substance of the claimed formula. Mixtures that may comprise the components of the substance cannot be said to necessarily comprise the crystalline ion association substance of the claimed formula.

Allowable Subject Matter

13. Claims 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. See the reasons of record in the Office Action mailed on 26 April 2005.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
12 October 2005


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER